

## **REMARKS**

The issues outstanding in the Office Action mailed December 3, 2003, are the requirement for restriction and the rejections under 35 U.S.C §112 and 103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

### **Requirement for Restriction**

Applicants maintain their traverse of the withdrawal of claim 22, drawn to coated articles. It is apparent that the coated article is related to the injection-molded produced article of claim 21 in the relationship of combination to sub-combination, inasmuch as claim 22 requires all of the elements of the article of claim 21. Where such a combination/sub-combination relationship is present, the M.P.E.P requires two-way distinctness be shown to support a restriction requirement. Such distinctness has not been shown, and cannot be, since, as noted, the coated article of claim 22 requires all the elements of claim 21. Thus, withdrawal of this portion of the restriction requirement is again respectfully requested.

With respect to the withdrawal of claims 4, 8, 27, 31, 32, 34 and 58 as drawn to non-elected species, it is respectfully submitted that, in view of the discussion below which establishes the patentability of the claims, the scope of examination should be extended to encompass the withdrawn claims. The same is respectfully requested.

### **Rejection Under 35 U.S.C §112**

Claims 1-3, 5-7, 9-21, 25, 26, 28, 30, 33, 35-57 and 59-61 have been rejected under 35 U.S.C §112, second paragraph. Reconsideration of this rejection is respectfully requested. The Examiner is sincerely thanked for her careful reading of the claims and her helpful comments at pages 2-4 of the Office Action. The claims have been amended in order to make numerous changes of a grammatical and typographical nature, and to respond to the majority of the Examiner's issues. In addition, Applicants have the following comments:

#### **1. Distinction Between Semi-Crystalline Polyamide (A) and Amorphous Polyamide (B):**

It is argued at page 2 of the Office Action that no distinction can be seen between the semi-crystalline polyamide (A) which contains partial amorphous character and the amorphous polyamide (B). In fact, the specification clearly explains the difference between the semi-crystalline polyamide and the amorphous polyamide, teaching that semi-crystalline polyamides have both a glass transition temperature and a melting point, while amorphous polyamides have a glass transition temperature but lack a melting point or have a melting point of an intensity which is negligible and does not affect the essentially amorphous of the polymer. These terms are used in accordance with their conventional definition in the art, as fully disclosed in the specification. See page 6, lines 5-20 of the present specification. Thus, it is clear that these terms are readily understandable, in view of the specification, by one of ordinary skill in the art.

**2. Component (A) Reads on Components (C), (D) and (M), etc.; Component (B) Reads on (C), (D) and (M):**

At the bottom of page 2 of the Office Action, it is argued that the semi-crystalline polyamide, (A), "also reads on" the polyamide (C), the compatibility agent (D) and the modifier (M). Regardless of the accuracy of this assertion, it is simply not seen that overlap between the various components of the composition is *per se* prohibited. In particular, the M.P.E.P states that the "double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to a rejection of claims." See M.P.E.P §2173.05(h). The MPEP continues that the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. Thus, inasmuch as (as explained below) one of ordinary skill in the art can clearly determine what is meant by each of components (A), (C), (D) and (M), there is no indefiniteness from the possibility that there may be overlap between one or more of these components. As a result, it is submitted that these recitations are not indefinite.

**3. Components (B1), (B2) and (B3):**

At page 3 of the Office Action, it is argued that components (B1), (B2) and (B3) do not limit the claimed subject matter, and the optional monomers do not distinguish from the required

monomers of (B1) or (B2). Minor modification has been made to this portion of the claim in order to clarify the status of these components. As above, the possibility of overlap does not render the claim indefinite.

**4. Compatibilizer (D) and Supple Modifier (M) are not Indefinite:**

It is further argued at page 3 of the Office Action, that compatibilizer (D) and supple modifier (M) are indefinite as to scope and meaning. Applicants respectfully disagree. First, compatibilizer (D) is defined at page 16, line 38 through page 17, line 1 of the specification, and numerous representative examples of the compatabilizer are given. For example, at page 17, line 5-35. Second, modifier (M) is defined and exemplified at page 20, lines 20-32, for example. See also page 17, line 36 through page 18, line 14. Again, the mere fact that there may be overlap between these components and other components of the composition does not, per se, result in indefiniteness. In view of the ample and clear definition and exemplification of these components, it is submitted that the claim reciting these materials is not indefinite.

**5. The Term "Equilibrated" is Clearly Defined in the Specification:**

At page 3, the Office Action argues that "equilibrated" in claims 4, 48 and 50 is indefinite. In fact, the term is defined at page 9, line 12 through page 10, line 26 of the specification, particularly at lines 3-7 of page 10. Thus, the use of the term in these claims is well defined and the claims are not indefinite.

**6. The Term "Catalysed" is not Indefinite:**

At page 3, the Office Action argues that the term "catalysed" is indefinite in claims 10, 11, 38, 55, and 56. In fact, at page 17, lines 5-35 of the specification, the "catalysed" polyamide (D) is clearly defined as one containing a polycondensation catalyst. Representative materials and representative catalysts are given at page 17, the portion noted above. Thus, one of ordinary skill in the art can clearly understand this term, and its usage is not indefinite.

**7. EPDM has Been Defined:**

At page 18, lines 18-25 of the present specification, the abbreviation EPDM is defined as ethylene-polypropylene-diene elastomers. As the Examiner notes at page 3 of the Office Action, the correct designation should be "ethylene-propylene," and suitable changes have been made to the claim.

**8. "Functionalized" is Clearly Defined in the Specification:**

At page 4 of the Office Action, the use of the term "functionalized" polyolefin in claim 39 is argued to be indefinite. In fact, page 18, lines 15-25 of the specification define the "functionalized" polyolefin as a polymer comprising alpha-olefin units and epoxy or carboxylic acid or carboxylic anhydride units. Thus, the use of the shorthand term "functionalized" is clearly definite.

**9. There is Antecedent Basis for Compatibilizer (B):**

At page 4 of the Office Action, it is argued that there is no antecedent basis for the term "compatibilizer (B)" in claim 46. First, it is submitted that the claim recites that the composition is one "further comprising" the compatibilizer. Moreover, the claim depends upon claim 33, which in turn depends upon claim 1, which provides antecedent basis for the compatibilizer.

In conclusion, it is submitted that the claims fully satisfy the requirements of the statute, and are definite. Withdrawal of the rejection under 35 U.S.C §112 is respectfully requested.

**Rejections Under 35 U.S.C §103**

Claims 1-3, 5, 9-11, 13-21, 25, 26, 28, 30, 33, 37, 38, 41-50 and 56 have been rejected under 35 U.S.C §103 over Dalla Torre '087. Reconsideration of this rejection is respectfully requested.

Dalla Torre is directed to "transparent, colorless *and* amorphous" polyamides. See column 1, lines 65-66. Patentees teach that these *amorphous* polyamides are made up of cycloaliphatic diamine and aliphatic dicarboxylic acid, or aliphatic diamine and cycloaliphatic dicarboxylic acid. See column 2, lines 1-8. Patentees indicate that materials may be present as a

blend with a "further polyamide". See column 2, lines 12-18. "Further polyamide" is defined at column 3 as comprising homopolyamides and copolyamides in an amount of up to 60% by wt. Further "homopolyamides" are listed at column 3, lines 5-15, and include PA 11 and PA 12. Example 4 of the patent shows 50% of polyamide and 50% of PA 12. As a result Patentees fail to suggest the production of an overall *semi-crystalline* blend, containing, for example, 35% or less of amorphous polyamides as in claim 1. (See also claims 13-20 and 63-71.) It is noted that newly added claims 63-71 are supported by the examples, particularly Table 2 at page 24 of the specification, and page 22. (It is noted that support for the recitation of such amorphous polyamides can be found, for example, in Table 1 at page 21 of the present specification. While explicit support for the value of 35 % is not given, it is well established that the disclosure of a range provides written description for a claim to a narrower portion of that range, even without explicit disclosure of end points. See, for example, *In re Werthheim*, 191 U.S.P.Q 90 (C.C.P.A. 1976).

Patentees clearly fail to suggest the production of a semi-crystalline composition, particularly since their "object" is obtained by the production of an *amorphous* material. Moreover, one of ordinary skill in the art would have no motivation to modify the materials of the patent, inasmuch as the expectation in the art is that transparent materials, *required* in the patent, necessitate the use of amorphous polyamides rather than semi-crystalline ones. Typically, one of ordinary skill in the art would not expect that compositions as presently claimed would be transparent. However, the examples in the present application clearly show that transparency is achieved. This provides further reason why the present claims are non-obvious. Withdrawal of the rejection is therefore respectfully requested.

Claim 6, 7, 12, 35, 36, 39, 40, 51-55, 57 and 59-61 have also been rejected under 35 U.S.C §103 over Dalla Torre taken with Schmid '799 and Giroud-Abel '213. Reconsideration of this rejection is also respectfully requested.

The deficiencies of Dalla Torre are discussed above. Inasmuch as the primary reference requires transparent materials, it is not seen that one of ordinary skill in the art would combine Schmid with Dalla Torre in a manner in so as to use *more* semi-crystalline material than the maximum amount therein, thus resulting in an overall semi-crystalline composition, since such

a (presumably non-transparent) composition is taught as being unsuitable in the primary reference.


Moreover, as discussed in the present specification, for example, at page 4, the second full paragraph, Schmid is consistent with the prior art in which the amorphous polyamide of a blend contains aromatic units. The disadvantage of the incorporation of such aromatic units is the necessary use of high blending temperature, resulting in risk of degradation and undesirable rigidity of the resulted product. Schmid discloses that their composition requires 25 to 45 mol parts of at least one aromatic dicarboxylic acid and, accordingly, does not suggest the presently claimed blend. Support for the exclusion of aromatic materials may be found in the present specification at page 4, line 27 through page 5, line 4.

Giroud-Abel, cited for its alleged teaching of the conventionality of adding elastomers to a blend, does nothing to remedy the deficiencies of the above two noted references. Accordingly, it is submitted that the claims are not suggested by this combination of references, and withdrawal of the rejection under 35 U.S.C §103 is respectfully requested.

The claims of the application are submitted to be in condition for allowance. However, if the Examiner has any questions or comments, she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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